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PATENT

Attorney Docket No. 463037-00080

Attorney File No. A-64558-1/RMS/RMK/SPL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Kayyem et al.

Serial No.: 08/873,597

Filed: June 12, 1997

For: *AC Methods for the
Detection of Nucleic Acids*

Group No. 1634

Examiner: Forman, Betty J.

CERTIFICATE OF MAILING

I hereby certify that this correspondence and its listed enclosures are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

Date:

Signature

Steve Lendaris

TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Petitioner, **Clinical Micro Sensors, Inc.**, represents that it is the assignee of the entire right, title, and interest of

(1) the instant application, U.S. Serial Number 08/873,597, filed June 12, 1997, which claims the benefit of the filing date of U.S. Serial Number 60/040,155, filed March 7, 1997; and

(2) U.S. Patent No. 6,248,299, filed October 13, 1999, which is a continuation of U.S. Patent No. 6,013,170, filed June 12, 1998, which is a continuation of U.S. Patent No. 6,013,459, filed June 12, 1997.

Written assignment proof for Serial No. 08/873,597, is recorded in the U.S. Patent and Trademark Office at Reel/Frame 88875/0764. Written proof for U.S. Patent 6,248,299, is recorded in the U.S. Patent and Trademark Office at Reel/Frame Number 9555/0167.

Copies of the assignments are attached to this Terminal Disclaimer.

Clinical Micro Sensors, Inc., hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154-156 and 173, as shortened by any terminal disclaimer of U.S. Patent No. 6,248,299.

Clinical Micro Sensors, Inc., hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.


In making the above disclaimer, **Clinical Micro Sensors, Inc.**, does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154-156 and 173 of U.S. Patent No. 6,248,299, as shortened by any terminal disclaimer, in the event that the patent later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer.

The undersigned is empowered to act on behalf of the petitioner/assignee. The undersigned has reviewed the evidentiary documents in the chain of title of the present

application identified above, and certifies that, to the best of assignee's knowledge and belief, title is in the assignee, **Clinical Micro Sensors, Inc.**

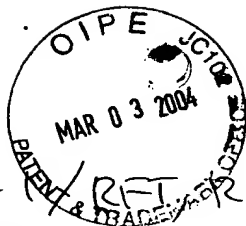
I, the undersigned, hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that willful, false statements may jeopardize the validity/enforceability of the application or any patent issued thereon.

Dated: March 1, 2004

By: 

Name: Steven P. Lencz

Title: Attorney for Clinical MicroSensors, Inc.



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
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Washington, D.C. 20231

A-64558-
FEBRUARY 18, 1998

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FLEHR HOHBACH TEST ET AL
ROBIN M. SILVA, ESQ.
SUITE 3400
FOUR EMBARCADERO CENTER
SAN FRANCISCO, CA 94111-4187



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UNITED STATES PATENT AND TRADEMARK OFFICE
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RECORDATION DATE: 01/05/1998

REEL/FRAME: 8875/0764
NUMBER OF PAGES: 4

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

KAYYEM, JON FAIZ

DOC DATE: 07/07/1997

ASSIGNOR:

O'CONNOR, STEPHEN D.

DOC DATE: 07/07/1997

ASSIGNEE:

CLINICAL MICRO SENSORS, INC.
101 WAVERLY DRIVE
PASADENA, CALIFORNIA 91105

SERIAL NUMBER: 08873597
PATENT NUMBER:

FILING DATE: 06/12/1997
ISSUE DATE:

MAYA BENNETT, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

ASSIGNMENT

(NOT ACCOMPANYING APPLICATION)

WHEREAS, the undersigned,

(1) Jon Faiz Kayyem, (2) Stephen D. O'Connor
(hereinafter termed "Inventors"), residents of
(1) Pasadena (2) Pasadena
respectively, Counties of
(1) Los Angeles (2) Los Angeles
respectively, States of
(1) California (2) California
respectively, have invented certain new and useful improvements in

ALTERNATING CURRENT METHODS FOR DETECTION OF NUCLEIC ACIDS

and have executed an application for a United States patent disclosing and identifying the invention on even date herewith; and having Serial No. 08/ 873,597 and filing date of 12 June 1997; and

WHEREAS, Clinical Micro Sensors, Inc. a corporation of the State of Delaware, having a place of business at 101 Waverly Drive, Pasadena, State of California, (hereinafter termed "Assignee"), is desirous of acquiring the entire right, title and interest in and to said application and the invention disclosed therein, and in and to all embodiments of the invention, heretofore conceived, made or discovered jointly or severally by said Inventors (all collectively hereinafter termed "said invention"), and in and to any and all patents, inventor's certificates and other forms of protection (hereinafter termed "patents") thereon granted in the United States and foreign countries.

NOW, THEREFORE, in consideration of good and valuable consideration acknowledged by said Inventors to have been received in full from said Assignee:

1. Said Inventors do hereby sell, assign, transfer and convey unto said Assignee, the entire right, title and interest (a) in and to said application and said invention; (b) in and to all rights to apply for foreign patents on said invention pursuant to the International Convention for the Protection of Industrial Property or otherwise; (c) in and to any and all applications filed and any and all patents granted on said invention in the United States or any foreign country, including each and every application filed and each and every patent granted on any application which is a division, substitution, or continuation of any of said applications; and (d) in and to each and every reissue or extensions of any of said patents.

2. Said Inventors hereby jointly and severally covenant and agree to cooperate with said Assignee to enable said Assignee to enjoy to the fullest extent the right title and interest herein conveyed in the United States and foreign countries. Such cooperation by said Inventors shall

petitions, oaths, specifications, declarations or other papers, and other assistance all to the extent deemed necessary or desirable by said Assignee (a) for perfecting in said Assignee the right, title and interest herein conveyed; (b) for prosecuting any of said applications; (c) for filing and prosecuting substitute, divisional, continuing or additional applications covering said invention; (d) for filing and prosecuting applications for reissuance of any said patents; (e) for interference or other priority proceedings involving said invention; and (f) for legal proceedings involving said invention and any applications therefor and any patents granted thereon, including without limitation opposition proceedings, cancellation proceedings, priority contests, public use proceedings, infringement actions and court actions; provided, however, that the expense incurred by said Inventors in providing such cooperation shall be paid for by said Assignee.

3. The terms and covenants of this assignment shall inure to the benefit of said Assignee, its successors, assigns and other legal representatives, and shall be binding upon said Inventors, their respective heirs, legal representatives and assigns.

4. Said Inventors hereby jointly and severally warrant and represent that they have not entered and will not enter into any assignment, contract, or understanding in conflict herewith.

IN WITNESS WHEREOF, the said Inventors have executed and delivered this instrument to said Assignee as follows:

✓ Date: July 7, 1997

✓ (1) Jon Faiz Kayyem

County of Los Angeles

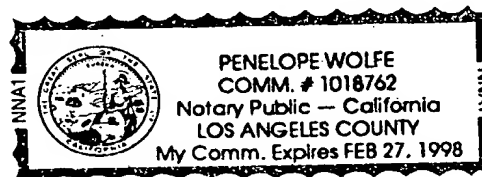
)
) ss.
)

State of California

On this 7th day of July, in the year 1997, before me, Penelope Wolfe, Notary Public of the State of California, personally appeared (1) Jon Faiz Kayyem, personally known to me ~~(or proved to me on the basis of satisfactory evidence)~~ to be the person whose name is subscribed to the within instrument, and acknowledged that he/~~she~~ executed the same in his/~~her~~ authorized capacity~~(ies)~~, and that by his/~~her~~ signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature Penelope Wolfe



(Seal)

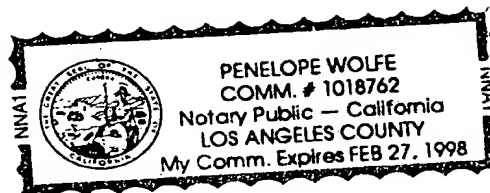
x Date: July 7, 1997 x (2) Stephen D. O'Connor
Stephen D. O'Connor

County of Los Angeles)
State of California) ss.
)

On this 7th day of July, in the year 1997, before me, Penelope Wolfe,
Notary Public of the State of California, personally appeared (2) Stephen D. O'Connor,
personally known to me ~~(or proved to me on the basis of satisfactory evidence)~~ to be the person
whose name is subscribed to the within instrument, and acknowledged that he/~~she~~ executed the
same in his/~~her~~ authorized capacity~~(ies)~~, and that by his/~~her~~ signature on the instrument the person,
or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature Penelope Wolfe
[560842]



(Seal)

File A-64 789-1 RFT
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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
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Washington, D.C. 20231

FEBRUARY 23, 1999

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FLEHR HOHBACH TEST ALBRITTON & HERBERT
ROBIN M. SILVA
SUITE 3400
FOUR EMBARCADERO CENTER
SAN FRANCISCO, CA 94111-4187



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RECORDATION DATE: 10/29/1998

REEL/FRAME: 9555/0167
NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

MEADE, THOMAS J.

DOC DATE: 09/11/1998

ASSIGNEE:

CLINICAL MICRO SENSORS, INC.
101 WAVERLY DRIVE
PASADENA, CALIFORNIA 91105

SERIAL NUMBER: 09096504

PATENT NUMBER:

FILING DATE: 06/12/1998

ISSUE DATE:

JOANN STEWART, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

10/29/98



100872267

to the Honorable Assistant Commiss
documents or copy thereof.

Please record the attached original

1. Name of conveying party(ies):

THOMAS J. MEADE

Additional name(s) of conveying
party(ies) attached? ☐ Yes ☒ No

3. Nature of Conveyance:

☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Other

Execution Date: September 11, 1998

2. Name and address of receiving party(ies):

Name: CLINICAL MICRO SENSORS, INC.

Internal Address:

Street Address: 101 WAVERLY DRIVE

City: PASADENA, CALIFORNIA

Country U.S.A. Zip: 91105

Additional name(s) & address(es) attached?

☐ Yes ☒ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is:

A. Patent Application No. (s)

09/096,504

B. Patent No. (s)

Additional numbers attached? ☐ Yes ☒ No5. Name and address of party to whom correspondence
concerning document should be mailed:Name: ROBIN M. SILVA
Internal Address: FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLPStreet Address: SUITE 3400
FOUR EMBARCADERO CENTER
City: SAN FRANCISCO
State: CA Zip: 94111-41876. Total number of applications
and patents involved:

1

7. Total fee (37 CFR 3.41):\$ 40.00

☒ Enclosed☐ Authorized to be charged to
deposit account

8. Deposit account number: 06-1300

Please debit any underpayment or credit any
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Our Order No. A-64789-1/RFT/RMS

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To the best of my knowledge and belief, the foregoing information is true and
correct and any attached copy is a true copy of the original document.ROBIN M. SILVA
Name of Person Signing
REG. NO. 38,304

Signature

Date

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File No. A-64789-1/RFT/RMS

Rev. 8/93 (600635)

11/05/1998 DNGUYEN 00000213 09096504

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ASSIGNMENT

WHEREAS, the undersigned, Thomas J. Meade (hereinafter termed "Inventor"), a resident of 1656 New York Drive, Altadena, County of Los Angeles, State of California, has invented certain new and useful improvements in DETECTION OF ANALYTES USING REORGANIZATION ENERGY; and having serial number 09/096,504 and filing date of 12 June 1998, and has executed concurrently herewith an application for a United States patent disclosing and identifying the invention; and

WHEREAS, Clinical Micro Sensors, Inc. (hereinafter termed "Assignee"), a corporation of the State of Delaware, having a place of business at 101 Waverly Drive, Pasadena, State of California, is desirous of acquiring the entire right, title and interest in and to said application and the invention disclosed therein, and in and to all embodiments of the invention, heretofore conceived, made or discovered by said Inventor (all collectively hereinafter termed "said invention"), and in and to any and all patents, inventor's certificates and other forms of protection (hereinafter termed "patents") thereon granted in the United States and foreign countries.

NOW, THEREFORE, in consideration of good and valuable consideration acknowledged by said Inventor to have been received in full from said Assignee:

1. Said Inventor does hereby sell, assign, transfer and convey unto said Assignee, the entire right, title and interest (a) in and to said application and said invention; (b) in and to all rights to apply for foreign patents on said invention pursuant to the International Convention for the Protection of Industrial Property or otherwise; (c) in and to any and all applications filed and any and all patents granted on said invention in the United States or any foreign country, including each and every application filed and each and every patent granted on any application which is a division, substitution, or continuation of any of said applications; and (d) in and to each and every reissue or extensions of any of said patents.

2. Said Inventor hereby covenants and agrees to cooperate with said Assignee to enable said Assignee to enjoy to the fullest extent the right title and interest herein conveyed in the United States and foreign countries. Such cooperation by said Inventor shall include prompt production of pertinent facts and documents, giving of testimony, execution of petitions, oaths, specifications, declarations or other papers, and other assistance all to the extent deemed necessary or desirable by said Assignee (a) for perfecting in said Assignee the right, title and interest herein conveyed; (b) for prosecuting any of said applications; (c) for filing and prosecuting substitute, divisional, continuing or

additional applications covering said invention; (d) for filing and prosecuting applications for reissuance of any said patents; (e) for interference or other priority proceedings involving said invention; and (f) for legal proceedings involving said invention and any applications therefor and any patents granted thereon, including without limitation opposition proceedings, cancellation proceedings, priority contests, public use proceedings, infringement actions and court actions; provided, however, that the expense incurred by said Inventor in providing such cooperation shall be paid for by said Assignee.

3. The terms, covenants and conditions of this assignment shall inure to the benefit of said Assignee, its successors, assigns and other legal representatives, and shall be binding upon said Inventor, his heirs, legal representatives and assigns.

4. Said Inventor hereby warrants and represents that he has not entered and will not enter into any assignment, contract, or understanding in conflict herewith.

IN WITNESS WHEREOF, the said Inventor has executed and delivered this instrument to said Assignee as follows:

X Date: 9-11-98

X By Thomas J. Meade
Thomas J. Meade

County of LOS ANGELES
State of CALIFORNIA

)
) ss.
)

On this 11 day of Sept., in the year 1998, before me, Penelope Wolfe, Notary Public of the State of Calif., personally appeared Thomas J. Meade, personally known to me ~~(or proved to me on the basis of satisfactory evidence)~~ to be the person whose name is subscribed to the within instrument, and acknowledged to me that he ~~she~~ executed the same in his ~~her~~ authorized capacity ~~(ies)~~, and that by his ~~her~~ signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature Penelope Wolfe

(Seal)

